



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,904	03/11/2004	James Michael McArdle	AUS920031066US1	7024

7590 09/07/2006

Gregory K. Goshorn
Hulsey Grether Fortkort + Webster, LLP
Suite 3200
8911 N. Capital of Texas Hwy.
Austin, TX 78759

EXAMINER

CAO, PHUONG THAO

ART UNIT PAPER NUMBER

2164

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/798,904

Applicant(s)

MCARDLE, JAMES MICHAEL

Examiner

Phuong-Thao Cao

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/11/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to Application filed on 03/11/2004.
2. Claims 1-25 are pending.

Information Disclosure Statement

3. The Information Disclosure Statement (IDS) filed by the Applicant on 03/11/2004 has been received and considered. A copy of the reviewed IDS is enclosed with this office action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10-14 recite the limitation "the method of claim 8" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5, 7-12, 14-19, 21-23 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Gulati et al. (US Patent No 6,924,827).

As to claim 1, Gulati et al. teach:

“A method for tracking metadata related to an information object inserted into a document” (see [column 3, lines 1-5]) the method comprising the steps of:

“compiling metadata describing an information object collected from a source document” (see [column 5, lines 5-15] and [column 16, lines 1-10] for capturing additional metadata);

“storing the metadata and the corresponding information object in a memory” (see [column 5, lines 15-25] and [column 6, lines 10-20]); and

“inserting the metadata into the first destination document when the information object is inserted into the first destination object” (see [column 6, lines 1-20] and [column 16, lines 1-30])

wherein requesting application or target application is equivalent to Applicant's "first destination document").

As to claim 2, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Gulati et al. teach:

"wherein the first destination document is a word processing document" (see [column 2, lines 1-5]).

As to claim 3, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Gulati et al. teach:

"wherein the information object is computer source code" (see [column 7, lines 65-67] and [column 8, lines 1-10] wherein any electronic data or data object is equivalent to Applicant's "computer source code").

As to claim 4, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Gulati et al. teach:

"wherein the metadata includes information providing attribution for the information object" (see [column 5, lines 10-15] and [column 16, lines 1-10]).

As to claim 5, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Gulati et al. teach:

“wherein the metadata includes information related to the source document” (see [column 16, lines 1-10]).

As to claim 7, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Gulati et al. teach:

“wherein the metadata is not viewable during at least one processing phase of the first destination document” (see [column 15, lines 20-30] wherein metadata such as bibliographic data is only viewable when requested by the user).

As to claim 8, Gulati et al. teach:

“A system for tracking metadata related to an information object inserted into a document” (see [column 1, lines 30-40], [column 3, lines 1-5] and [column 15, lines 55-65]), comprising:

“a computing system” (see [column 4, lines 45-55]);

“a source document” (see [column 8, lines 1-20]);

“a first destination document” (see [column 6, lines 10-20] and [column 16, lines 20-30] wherein requesting application or target application is equivalent to Applicant’s “first destination document”);

“an information object collected from the source document” (see [column 5, lines 1-15] and [column 7, lines 65-67] wherein captured electronic data is equivalent to Applicant’s “information object”);

“a metadata object describing the information object” (see [column 5, lines 5-15] and [column 12, lines 17-20] wherein gem data object, which contains metadata describing or referring to the original data is equivalent to Applicant’s “metadata object”); and

“logic, executed on the computing system, for inserting the metadata object into the first destination document when the information object is inserted into the first destination object” (see [column 6, lines 1-20] and [column 16, lines 1-30] wherein requesting application or target application is equivalent to Applicant’s “first destination document”).

As to claim 9, this claim is rejected based on arguments given above for rejected claim 8 and is similarly rejected including the following:

Gulati et al. teach:

“wherein the first destination document is a word processing document” (see [column 2, lines 1-5]).

As to claim 10, this claim is rejected based on arguments given above for rejected claim 8 and is similarly rejected including the following:

Gulati et al. teach:

“wherein the information object is computer source code” (see [column 7, lines 65-67] and [column 8, lines 1-10] wherein any electronic data or data object is equivalent to Applicant’s “computer source code”).

As to claim 11, this claim is rejected based on arguments given above for rejected claim 8 and is similarly rejected including the following:

Gulati et al. teach:

“wherein the metadata includes information providing attribution for the information object” (see [column 5, lines 10-15] and [column 16, lines 1-10]).

As to claim 12, this claim is rejected based on arguments given above for rejected claim 8 and is similarly rejected including the following:

Gulati et al. teach:

“wherein the metadata includes information related to the source document” (see [column 16, lines 1-10]).

As to claim 14, this claim is rejected based on arguments given above for rejected claim 8 and is similarly rejected including the following:

Gulati et al. teach:

“wherein the metadata is not viewable during at least one processing phase of the first destination document” (see [column 15, lines 20-30] wherein metadata such as bibliographic data is only viewable when requested by the user).

As to claim 15, Gulati et al. teach:

“A computer program product for tracking metadata related to an information object inserted into a document” (see [column 1, lines 30-37], [column 5, lines 1-15] and [column 6, lines 13-20]), comprising:

“a recording medium” (see [column 4, lines 55-60]);

“means, stored on the recording medium, for compiling metadata describing an information object collected from a source document” (see [column 5, lines 5-15] for capturing additional metadata, as illustrated in Applicant’s claim language);

“means, stored on the recording medium, for storing the metadata and the corresponding information object in a memory” (see [column 5, lines 15-25] and [column 6, lines 10-20]); and

“means, stored on the recording medium, for inserting the metadata into the first destination document when the information object is inserted into the first destination object” (see [column 6, lines 1-20] and [column 16, lines 1-30] wherein requesting application or target application is equivalent to Applicant’s “first destination document”).

As to claim 16, this claim is rejected based on arguments given above for rejected claim 15 and is similarly rejected including the following:

Gulati et al. teach:

“wherein the first destination document is a word processing document” (see [column 2, lines 1-5]).

As to claim 17, this claim is rejected based on arguments given above for rejected claim 15 and is similarly rejected including the following:

Gulati et al. teach:

“wherein the information object is computer source code” (see [column 7, lines 65-67] and [column 8, lines 1-10] wherein any electronic data or data object is equivalent to Applicant’s “computer source code”).

As to claim 18, this claim is rejected based on arguments given above for rejected claim 15 and is similarly rejected including the following:

Gulati et al. teach:

“wherein the metadata includes information providing attribution for the information object” (see [column 5, lines 10-15] and [column 16, lines 1-10]).

As to claim 19, this claim is rejected based on arguments given above for rejected claim 16 and is similarly rejected including the following:

Gulati et al. teach:

“wherein the metadata includes information related to the source document” (see [column 16, lines 1-10]).

As to claim 21, Gulati et al. teach:

“A method for compiling and storing metadata” (see [column 5, lines 15-25] and [column 12, lines 15-35]), comprising the steps of:

“compiling metadata corresponding to an information object collected from a source document, wherein the metadata is information related to the information object” (see [column 5, lines 5-15] wherein captured electronic data is equivalent to Applicant’s “information object” and capturing metadata is equivalent to compiling metadata as illustrated in Applicant’s claim language);

“inserting the information object into the first destination document” (see [column 6, lines 13-20] wherein the requesting application is equivalent to Applicant’s “first destination document and pasting data means inserting data or the information object as illustrated in Applicant’s claim language); and

“storing the metadata in conjunction with the first destination document such that the metadata can be correlated with the information object” (see [column 12, lines 28-58] and [column 16, lines 20-30] wherein the target application is equivalent to Applicant’s “first destination document” and bibliographic data is equivalent to metadata as illustrated in Applicant’s claim language).

As to claim 22, this claim is rejected based on arguments given above for rejected claim 21 and is similarly rejected including the following:

Gulati et al. teach:

“wherein the metadata is information related to the source of the information object” (see [column 16, lines 1-10]).

As to claim 23, this claim is rejected based on arguments given above for rejected claim 21 and is similarly rejected including the following:

Gulati et al. teach:

“wherein the metadata is stored in the first destination document” (see [column 16, lines 20-30] wherein the target application is equivalent to Applicant’s “first destination document”, and bibliographic data is equivalent to Applicant’s “metadata”).

As to claim 25, Gulati et al. teach:

“A method of accessing metadata and associating the metadata with an information object” (see [column 15, lines 50-65]), comprising the steps of:

“accessing the first document” (see [column 15, lines 50-65] wherein view of a popup window for the gem object “Functions of Patent and Trademark Office” is equivalent to Applicant’s “first document”); and

“retrieving a metadata object, stored in conjunction with the first document and associated with an information object included in the first document, wherein the metadata object includes information relating to the source of the information object” (see [column 15, lines 55-65] wherein tab 822 provides a way to retrieve metadata information about data contained in the gem data object, wherein the data contained in the gem data object is equivalent to Applicant’s information object).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6, 13, 20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gulati et al. (US Patent No 6,924,827) as applied to claims 1, 8, 15 and 21 above, and further in view of Denoue et al. (Publication No US 2003/0051615).

As to claims 6, 13, 20 and 24, these claims are rejected based on arguments given above for rejected claims 1, 8, 15 and 21 and are similarly rejected including the following:

Gulati et al. does not teach “inserting the metadata into a second destination document rather than the first destination document, wherein the second destination document is associated with the first destination document”.

Denoue et al. teach “inserting the metadata into a second destination document rather than the first destination document, wherein the second destination document is associated with the first destination document” (see [0090] and [0091] wherein retrieving properties or metadata by scanning the identifier printed along with the content indicates that these metadata must be stored in a document referenced by the identifier and different from the printed document wherein the printed document is equivalent to Applicant’s “first destination document”).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Gulati et al. by the teaching of Denoue et al., since both Gulati et al. and Denoue et al. implement a system which allows gathering data from various sources, and tracking and attributing such data used to its original source, and inserting the metadata into a second destination document instead of the first destination document and associated the second destination document to the first destination document provides one more flexible and effective way to access and manage the metadata.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Huynh et al. (Publication No US 2002/0198909) teach a method for recognizing data, including text strings and media objects by labeling data with semantic information on-the-fly as a user is typing text or inserting a media object into a document and creating a document. The act of importing a media object into an electronic document includes importing semantic information from the repository where the media object resides.

Dozier et al. (Publication No US 2003/0041117) teach a method and apparatus for publishing hypermedia content in electronic form across the wide area networks.

Janssen et al. (Publication No US 2002/0147725) teach a method for copying metadata from any column of any already existing database table into a target definition table for defining the table properties of a column of another table.

Diamond et al. (US Patent No 6,591,295) teach a method of using a clipboard application program to transfer the Web URLs designating those objects stored in relational database tables to other Web applications.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong-Thao Cao whose telephone number is (571) 272-2735. The examiner can normally be reached on 8:30 AM - 5:00 PM (Mon - Fri).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PTC

August 29, 2006

Julie S. Hassam
Primary Examiner
Art. Unit 2167